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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/815,055 | 03/31/2004 | David Geiger | Geiger (MD-277) | 7936 |
| 1342 | 7590 | 05/19/2005 | EXAMINER | |
| PHILLIPS LYTLE LLP INTELLECTUAL PROPERTY GROUP 3400 HSBC CENTER BUFFALO, NY 14203-3509 | | | LESLIE, MICHAEL S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3745 | |

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/815,055 | GEIGER, DAVID | |
| | Examiner | Art Unit | |
| | Michael Leslie | 3745 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) 1-12 is/are allowed.
- 6) Claim(s) 13-16 and 19 is/are rejected.
- 7) Claim(s) 17, 18 and 20-22 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(ā)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it exceeds the limit of 150 words.

Correction is required. See MPEP § 608.01(b).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13, 14, 15, 16, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 1, 2, 3, and 5, respectively, of U.S. Patent No. 6851261. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 1, 2, 3, and 5 of U.S. Patent No. 6851261 "anticipate" Application claims 13, 14, 15, 16, and 19, respectively. Accordingly, Application claims 13, 14, 15, 16, and 19 are not patentably distinct from Patent claims 1, 1, 2, 3, and 5, respectively.

Here, Patent claim 1, requires:

1. A servoactuator for selectively controlling the movement of an output member in two directions in response to a command signal, comprising:
 - an electric motor having a rotatable output shaft;
 - a motor controller arranged to provide a drive current to said motor for controllably rotating said output shaft;
 - a first transmission mechanism operatively arranged to displace said output member in either direction at a nominal first ratio with respect to said motor output shaft;
 - a hydrostatic second transmission mechanism operatively arranged to displace said output member in either direction at a nominal second ratio with respect to said motor output shaft;
 - a transfer mechanism operatively arranged to selectively couple said motor output shaft to said output member either through said first transmission mechanism to impart a high-speed low-force drive to said output member, or through said second transmission mechanism to impart a low-speed high-force drive to said output member;
 - at least one feedback transducer capable of measuring one of the force, displacement or velocity of said output member, and
 - a servo control loop closed about said motor, controller, transmission mechanisms, transfer mechanism, feedback transducer and output member for selectively controlling at least one of the position, velocity or force of said output member as a function of said command signal.

While Application claims 13 and 14 require:

13. A servoactuator for selectively controlling the movement of an output member in two directions relative to a frame in response to a command signal, comprising:

an electric motor having an output shaft;

a motor controller arranged to provide a drive current to said motor for controllably moving said output shaft;

a first transmission mechanism operatively arranged to displace said output member in either direction at a nominal first ratio with respect to said motor output shaft;

a hydrostatic second transmission mechanism operatively arranged to displace said output member in either direction at a nominal second ratio with respect to said motor output shaft; and

a transfer mechanism operatively arranged to selectively couple said motor output shaft to said output member either through said first transmission mechanism to impart a high-speed low-force drive to said output member, or through said second transmission mechanism to impart a low-speed high-force drive to said output member.

14. A mechanism as set forth in claim 13, and further comprising:

at least one feedback transducer capable of measuring one of the force, displacement or velocity of said output member; and

a servo control loop closed about said motor, controller, transmission mechanisms, transfer mechanism, feedback transducer and output member for selectively controlling at least one of the position, velocity or force of said output member as a function of said command signal.

Further, Patent claims 2, 3, and 5 require:

2. A servoactuator as set forth in claim 1, and further comprising:
an engaging device for selectively coupling said second transmission mechanism to said output member at any position of said output member.
3. A servoactuator as set forth in claim 1 wherein said first transmission mechanism is hydrostatic.
5. A servoactuator as set forth in claim 1 wherein said first transmission mechanism includes a screw thread and nut.

While Application claims 15, 16, and 19 require:

15. A mechanism as set forth in claim 13, and further comprising:
an engaging device for selectively coupling said second transmission mechanism to said output member at any position of said output member.
16. A mechanism as set forth in claim 13 wherein said first transmission mechanism is hydrostatic.
19. A mechanism as set forth in claim 13 wherein said first transmission mechanism includes a screw thread and nut.

Thus, it is apparent that the more specific Patent claims 1, 1, 2, 3, and 5 encompasses Application claims 13, 14, 15, 16, and 19, respectively. Following the rationale in *In re Goodman* cited in the preceding paragraph, where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since application claims 13, 14, 15, 16, and 19 are anticipated by Patent claims 1, 1, 2, 3, and 5, respectively and since anticipation is the epitome of obviousness, then Application claims 13, 14, 15, 16, and 19 are obvious over Patent claims 1, 1, 2, 3, and 5, respectively.

Allowable Subject Matter

Claims 1-12 are allowed.

Claims 17, 18, and 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents 4968239, 5345766, and 6439875 each disclose servoactuators with hydraulic force amplification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Leslie whose telephone number is (571) 272-4819. The examiner can normally be reached on M-F 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
May 11, 2005

Michael Leslie
Michael Leslie
Patent Examiner
AU 3745

Edward K. Look
EDWARD K. LOOK
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5/13/05